In the Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-620

EDWARD S. IRONS, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

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1. Petitioner seeks a writ of certiorari to review the court of appeals' denial of a motion for summary reversal and denial of a petition for rehearing *en banc* on that issue. The merits of the appeal are still pending before the court of appeals, although briefs have not yet been filed.

In this suit under the Freedom of Information Act, 5 U.S.C. 552, petitioner seeks access to all unpublished manuscript decisions of the Patent Office together with such indices as are available. The district court dismissed the request for manuscript decisions on the ground that it was "not a reasonable request for identifiable records, but rather a broad, sweeping, indiscriminate request for production lacking any specificity," and ordered the Patent Office to prepare a public index of post-July 1967 manuscript decisions. 321 F. Supp. 628. On appeal, the court of appeals affirmed the dismissal of the request for all un-

published manuscript decisions, but remanded for consideration of whether certain pre-existing indices could be disclosed to petitioner; and whether the complaint could be amended to make an acceptable request for the records sought.

On remand, the district court ordered the Patent Office to disclose indices, consisting of the name in which the patent application was filed and the page number, contained in 144 bound volumes of manuscript decisions, but refused petitioner's request for "docket cards" and "file wrapper jackets," on the grounds that the documents are not an index and are exempt from disclosure under 35 U.S.C. 122. The court refused to allow the complaint to be amended, on the grounds that the proposed amendments would not cure the defects of the original complaint and that the new matters raised in the proposed amendments were then before the court on various motions.

Petitioner moved to vacate the order and recuse the judge on the ground that the order revealed that the district judge had engaged in *ex parte* contacts with the respondent's representatives concerning controverted matters. The district court denied the motion, acknowledging contacts between a member of the judge's staff and the Patent Office, but denying that plaintiff had been prejudiced thereby.

Petitioner appealed to the court of appeals and asked for a summary reversal of the district court's order. The court of appeals, *per curiam,* denied petitioner's motion for summary reversal, and denied a petition for rehearing *en banc.*

The appeal on the merits is presently pending before the court of appeals, although briefs have not yet been filed.

2. No issue warranting further review is presented at this time.

The conduct of the district judge was in no way improper. As Judge Gasch pointed out in his order denying petitioner's motion to vacate the judgment, his actions in sending a member of his staff to inspect the indices involved in this case amounted merely to a "physical identification of material" (Pet. App. 19a).

3. Even if the conduct of the district judge had been improper, summary reversal is not warranted. Petitioner was not prejudiced by the court's physical identification of material. Any facts which allegedly were determined as a result of this determination were fully supported by the record in this case, or were undisputed and available, upon request, to any member of the public, or were found in petitioner's favor.

Nor did the other alleged improprieties deny petitioner a fair hearing. The district judge was acting entirely within his discretion in refusing to allow respondent's counsel, Mr. Martin, to be deposed.[1]

The question of alleged deficiencies in the index prepared by the Patent Office was fully presented to the district court, which held that petitioner must make a formal request to the Patent Office for those portions of the index in contention before the court would consider the question of noncompliance with *its own* order (see C.A. App. 80). The court clearly stated that if petitioner were not satisfied with the Patent Office's response, he could come back to the district court for relief. Moreover, in the memorandum-order of January 10, 1974, the court in effect held that non-final manuscript opinions do not fall within the categories of 5 U.S.C. 552(a)(2)(B) and (C), and, thus, were not required to be indexed under the order of October 26, 1970.

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[1]The facts regarding the matters in Mr. Martin's affidavit were known by other Patent Office officials, yet petitioner made no effort to depose anyone other than Mr. Martin.

Finally, respondent's failure to counter petitioner's "statement of material facts as to which there is no genuine issue" is immaterial. This litigation is over four years old. The issues, including the availability of the 175 bound volumes, have been hotly contested throughout the litigation, and it would have been exalting form above substance to accept that statement of facts as dispositive on the record as it stood.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ROBERT H. BORK,
Solicitor General.

JANUARY 1975.